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REMARKS

The present response is intended to be fully responsive to all points of objection and/or rejection raised by the Examiner and is believed to place the application in condition for allowance. Applicants assert that the present invention is new, non-obvious and useful. Prompt consideration and allowance of the claims is respectfully requested.

Status of Claims

Claims 1-4, 6, 9, 13, 17-19, 21, 22, 25, 30-32, 34 and 37-39 are pending. Claims 9, 17-19, 21, 22, 25, 30, 38 and 39 have been withdrawn. Claims 1-4, 6, 13, 31, 32, 34 and 37 have been rejected.

Claims 2, 17-19, 21-22, 25, 30, 38 and 39 have been canceled without prejudice or disclaimer. In making this cancellation without prejudice, Applicants reserve all rights in these claims to file divisional and/or continuation patent applications.

Claims 1, 3, 6, 9, 13 and 31 have been amended herein. Applicants assert that the amendments to claims 1, 13 and 31 add no new matter.

New claims 40-48 have been added in order to further define what Applicants consider to be the invention. Applicants respectfully assert that no new matter has been added.

Remarks to the Telephone Restriction and Election

In the Office Action, the Examiner required affirmation of a restriction to one of the following allegedly distinct inventions:

Claims 1-4, 6, 9, 13, 31-32, 34 and 37 drawn to an apparatus and system; and

Claims 38, 17-19, 21-22, 25, 30 and 39 drawn to a method.

According to the Examiner, the inventions are distinct because the heat sensitive filament can be used without the step of activating a component in the first part, and because the inventions have acquired a separate status in the art in view of their different classification and due to their recognized divergent subject matter.

According to the Examiner, the undersigned attorney elected, without traverse, to prosecute claims 1-4, 6, 9, 13, 31-32, 34 and 37 drawn to an apparatus and system. Applicants hereby affirm, without traverse, the election of claims 1-4, 6, 9, 13, 31-32, 34 and 37 drawn to an apparatus and system. Claims 17-19, 21-22, 25, 30, 38 and 39 drawn to a method have been canceled herein without prejudice or disclaimer.

In the Office Action, the Examiner required affirmation of a telephone election of the following allegedly patentably distinct species of fastener:

- a heat sensitive filament;
- a magnet; and
- a degradable filament.

According to the Examiner, the species are independent or distinct because they do not overlap in scope, are mutually exclusive and are not obvious variants of each other based on the current record.

According to the Examiner, the undersigned attorney elected, without traverse, to prosecute the degradable filament species. It is noted, however, that the Examiner has mischaracterized the undersigned's telephone election of the degradable species election as being without traverse, when in fact the election of species requirement was disputed during the telephone election. As such, Applicants affirm the election of the degradable filament species for the purposes of responding to the Examiner's election of species requirement but make this election with traverse, in light of the remarks that follow.

Applicants point out that the above-listed three separate species of fasteners is in fact two separate species of fastener, rather than three. The Examiner has erred, because "the heat sensitive filament" and "the degradable filament" are not mutually exclusive species and in fact are members of a single species. Applicants point out that the Examiner appears to have misconstrued the coordinating conjunction "or" at least on page 11, line 18 of the specification as filed, where it is recited that the fastener may be a "heat sensitive or degradable filament." The Examiner appears to have interpreted this as meaning that the fastener may be either a heat sensitive filament or a degradable filament. Instead, Applicants intended this to be understood that the fastener may be a filament that is sensitive or degradable as a result of the application of heat. That is, the filament is sensitive to heat and

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degrades as a result of the application of heat. Indeed, if the filament degrades by application of heat, then it is necessarily sensitive to that heat. Thus, contrary to the Examiner's indication, these two species overlap in scope and are not mutually exclusive.

Accordingly, Applicants respectfully assert that it would not be a burden on the Examiner to search for a heat sensitive, degradable filament and respectfully request that the Examiner withdraw the election of species requirement with regard to the heat sensitive filament and the degradable filament and permit Applicants to elect a heat sensitive, degradable filament as the species for prosecution.

CLAIM REJECTIONS

35 U.S.C. § 102 Rejections

In the Office Action, the Examiner rejected claims 1-4, 6, 13, 31-32, 34 and 37 under 35 U.S.C. § 102(a), as being anticipated by Lewkowicz (U.S. Patent Application Publication No. 2003/0018280). Applicants respectfully traverse this rejection in view of the remarks that follow.

According to the Examiner, Lewkowicz discloses an in-vivo sensing device comprising a first part having a first specific gravity (Lewkowicz's 'sensor system 32' [0028]), a second part having a second specific gravity (Lewkowicz's 'buoy 34' [0028]), wherein the first part and the second part are (inherently) detachable.

Applicants point out that, pursuant to M.P.E.P. §2112(IV), the Examiner must provide a rationale or evidence tending to show inherency. Specifically, M.P.E.P. §2112(IV) recites:

"The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of the result or characteristic.... In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art," (emphasis in original).

In his rejection, the Examiner rejects independent claim 1, claim 13 and independent 31, at least partly, based on inherency wherein the Examiner indicates that the first part and second part are (inherently) detachable, that the first part is (inherently) configured to detach in-vivo, and that the first part and second part are attached by a (inherently) releasable

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faster, respectively. However, the Examiner failed to provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics recited in claims 1, 13 and 31 necessarily flow from the teachings of Lewkowicz. Nowhere in Lewkowicz is it taught or suggested that any part of Lewkowicz's device detaches or is detachable from another part of Lewkowicz device. Nor is detachability of one part of Lewkowicz's device from another part a characteristic necessarily flowing from the teaching of Lewkowicz. Accordingly, the Examiner's rejections of independent claim 1, claim 13 and independent 31 are improper at least in regard to the Examiner's inherency arguments, and the rejections should be withdrawn.

Nevertheless, in order to expedite prosecution of the subject application towards allowance, Applicants have herein amended independent claims 1 and 31 to now recite, *inter alia*, "a first part having a specific gravity of less than one or approximately one; a second part having a specific gravity of more than one;...and...wherein, when the first part and second part are connected, the specific gravity of the device is greater than one." Support for these amendments can be found in the specification as filed, for example at page 4, line 1-24, and at page 8, line 13 - page 10, line 6. Applicants respectfully assert that Lewkowicz does not teach or suggest at least these elements of independent claims 1 and 31.

In view of the foregoing, Applicants assert that amended independent claims 1 and 31 are allowable. Claims 3-4, 6, 13, 32, 34 and 37 depend, directly or indirectly, from amended independent claims 1 and 31 and therefore include all the limitations of those claims. Therefore, Applicants respectfully assert that claims 3-4, 6, 13, 32, 34 and 37 are likewise allowable. Accordingly, Applicants respectfully request that the Examiner withdraw the rejection to amended independent claims 1 and 31 and to claims 3-4, 6, 13, 32, 34 and 37 dependent thereon.

New Claims

Applicant have herein added new claims 40-48 in order to further define what the Applicants consider to be the invention. Support for new claims 40 and 41 may be found in the specification as filed at, *inter alia*, page 14, lines 8-11. Support for new claim 42 may be found in the specification as filed at, *inter alia*, page 9, lines 21-25. Support for new claim 43 may be found in the specification as filed at, *inter alia*, page 12, lines 11-13. Support for new

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claim 44 may be found in the specification as filed at, *inter alia*, page 12, lines 21-23. Support for new claim 45 may be found in the specification as filed at, *inter alia*, page 14, lines 1-3. Support for new claim 46 may be found in the specification as filed as original claim 10 and at, *inter alia*, page 14, lines 20-23. Support for new claim 47 may be found in the specification as filed at, *inter alia*, at page 5, lines 21-23, and page 18, lines 14-16. Support for new claim 48 may be found in the specification as filed as original claim 35 and at, *inter alia*, page 13, lines 21-25.

New claims 40-48 depend, directly or indirectly, from amended independent claim 1 and therefore include all the limitations of that claim. Accordingly, Applicants respectfully assert that new claims 40-48 are likewise allowable.


Conclusion

In view of the foregoing amendments and remarks, Applicants assert that the pending claims are allowable.

Should the Examiner have any question or comment as to the form, content or entry of this Amendment, the Examiner is requested to contact the undersigned at the telephone number below. Similarly, if there are any further issues yet to be resolved to advance the prosecution of this application to issue, the Examiner is requested to telephone the undersigned counsel.

Please charge any fees associated with this paper to deposit account No. 50-3355.

Respectfully submitted,


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Dated: September 1, 2011

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